



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,088	06/05/2001	Douglas Fisher	01-103	7712
23843	7590	10/08/2004	EXAMINER	
HOWARD E LEBOWITZ 19682 HESPERIAN BLVD Suite 208 HAYWARD, CA 94541			WORLOH, JALATEE	
		ART UNIT	PAPER NUMBER	
		3621		

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/875,088	FISHER, DOUGLAS
	Examiner	Art Unit
	Jalatee Worjoh	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 July 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-31 and 34-36 is/are pending in the application.
 - 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) 22-36 is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) 12-21 is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed July 6, 2004, in which claims 1-16 and 27,29-31,33,34 and 36 were amended.

Response to Arguments

2. Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.
3. Claims 1-31 and 34-36 have been examined.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Publication NO. 2003/0095726 to Kia et al. in view of US Patent No. 6598027 to Breen, Jr. et al.

Kia et al. disclose enrolling a multiplicity of users (i.e. merchants and cardholders) with a closed authentication infrastructure, wherein enrolling comprises obtaining and verifying the identity and other credentials of the multiplicity of users and providing each user with a unique secret necessary for later authentication to said online authentication service and storing the

Art Unit: 3621

verified identity and other credentials in at least one database, authenticating a plurality of the multiplicity of users to said on-line authentication service using user's unique secret to produce a plurality of authenticated users (see paragraphs [033] and [0393]). Kia et al. do not expressly disclose a plurality of groups each group comprising at least two of said plurality of authenticated users to conduct interactions comprising a plurality of messages under persistent mediation of said online authentication service, such that each of and is directly monitored by said online authentication service. Breen, Jr. et al. disclose a plurality of groups each group comprising at least two of said plurality of authenticated users to conduct interactions comprising a plurality of messages under persistent mediation of said online authentication service, such that each of and is directly monitored by said online authentication service (see col. 1, lines 58-67 & col. 2, lines 17-35). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Kia et al. to include a plurality of groups each group comprising at least two of said plurality of authenticated users to conduct interactions comprising a plurality of messages under persistent mediation of said online authentication service, such that each of and is directly monitored by said online authentication service. One of ordinary skill in the art would have been motivated to do this because it monitors users transactions, which is necessary to reduce future disputes.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kia et al. and Breen et al. as applied to claim 1 above, and further in view of US Publication No. 2003/0004894 to Rowney et al.

Kia et al. discloses an online authentication service (see claim 1 above). Kia et al. do not expressly disclose providing each of the at least two users in an interaction verified information

Art Unit: 3621

about each other user in the interaction in an intelligible form before beginning the interactions, whereby each user may decide whether to proceed with an interaction based on the verified information provided by the on-line authentication service. Rowney et al. disclose providing each of the at least two users in an interaction verified information about each other user in the interaction in an intelligible form before beginning the interactions, whereby each user may decide whether to proceed with an interaction based on the verified information provided by the on-line authentication service (see paragraphs [0080] & [0083]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the Kia et al. to include the step of providing each of the at least two users in an interaction verified information about each other user in the interaction in an intelligible form before beginning the interactions, whereby each user may decide whether to proceed with an interaction based on the verified information provided by the on-line authentication service. One of ordinary skill in the art would have been motivated to do this because it eliminates future disputes by reducing undesirable interactions.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kia et al. and Breen, Jr. et al. as applied to claim 1 above, and further in view of US Publication No. 2004/0128257 to Okamoto et al.

Kia et al. disclose a persistent mediation method (see claim 1 above). Kia et al. do not expressly disclose directly compiling an audit trail of an interaction and making the audit trail available to the at least two users in the interaction in an intelligible form at any tie during the interaction at the option of the at least two users and wherein the audit trail comprises at least some of the content of the plurality of messages in the interaction. Okamoto et al. disclose

compiling an audit trail of an interaction and making the audit trail available to the at least two users in the interaction in an intelligible form at any tie during the interaction at the option of the at least two users and wherein the audit trail comprises at least some of the content of the plurality of messages in the interaction (see paragraph [0093]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Kia et al. to include the step of compiling an audit trail. One of ordinary skill in the art would have been motivated to do this because it monitors users transactions, which is necessary to reduce future disputes.

8. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kia et al. and Breen, Jr. et al. as applied to claim 1 above, and further in view of “Software Smart Cards via Cryptographic Camouflage” to Hoover et al.

Kia et al. disclose the unique secret comprises a private encryption key and closed authentication system (see claim 1 above). Kia et al. do not expressly disclose the closed authentication system comprises a pseudo-PKI system of type which cryptographically camouflages a user’s private encryption key in a software container, whereby the user’s camouflaged private key will generate a correct response to an authentication challenge if a proper access code is entered, but often generates an incorrect but plausible response which if used will provide a notice to the on-line authentication service of security attack on the camouflaged key. Hoover et al. disclose a pseudo-PKI system of type which cryptographically camouflages a user’s private encryption key in a software container, whereby the user’s camouflaged private key will generate a correct response to an authentication challenge if a proper access code is entered, but often generates an incorrect but plausible response which if

used will provide a notice to the on-line authentication service of security attack on the camouflaged key (see entire document). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Kia et al. to include a pseudo-PKI system of type which cryptographically camouflages a user's private encryption key in a software container, whereby the user's camouflaged private key will generate a correct response to an authentication challenge if a proper access code is entered, but often generates an incorrect but plausible response which if used will provide a notice to the on-line authentication service of security attack on the camouflaged key. One of ordinary skill in the art would have been motivated to do this because it provides additional security.

Referring to claim 5, Kia et al. disclose the method wherein enrolling a multiplicity of users further comprises the act of providing each of said multiplicity of users with a public key encrypted on a certificate which can only be decrypted using a secret key under exclusive control of the on-line authentication service, whereby the pseudo-PKI system operates as a closed authentication infrastructure and the online authentication service is capable of authenticating users without storing a cryptographic key of the user other than during the act of authenticating (see paragraph [0388]).

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kia et al. and Breen et al in view of Okamoto et al.

Kia et al disclose enrolling users seeking enrollment in the persistent authentication and mediation service, to produce a multiplicity of enrolled users, wherein enrolling comprises obtaining and verifying the identity and other credentials of the multiplicity of users and providing each user with a unique secret necessary for later authentication to said online

persistent authentication and mediation service, storing the verified identity and other credentials in at least one database, receiving online requests from enrolled users for authentication to online authentication service, authenticating enrolled users seeking authentication to the persistent authentication and mediation service using each enrolled user's unique secret, so as to maintain a plurality of authenticated users, mediating the interaction among the at least two users of each of said plurality of groups of connected users such that each message in the interaction passes through the persistent authentication and mediation service (see paragraphs [0388] and [0393]).

Kia et al. do not expressly disclose receiving request from authenticated users to be connected to particular other authenticated users, connecting groups of at least two authenticated users under persistent mediation of the persistent authenticated users which are connected to conduct an interaction comprising a plurality of messages, repeating act (f) to produce a plurality of groups of connected users or directly compiling an audit trail of the interaction and making information from the audit trail available to the at least two users of each group of connected users during the interaction in an intelligible form wherein the audit trail contains at least some of the content of the plurality of messages in the interaction. The steps of receiving requests from authenticated users to be connected to particular other authenticated users and repeating act (f) to produce a plurality of groups of connected users are inherent step. Okamoto et al. disclose compiling an audit trail of an interaction and making the audit trail available to the at least two users in the interaction in an intelligible form at any tie during the interaction at the option of the at least two users and wherein the audit trail comprises at least some of the content of the plurality of messages in the interaction (see paragraph [0093]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Kia et

Art Unit: 3621

al. to include the steps of receiving request from authenticated users to be connected to particular other authenticated users, connecting groups of at least two authenticated users under persistent mediation of the persistent authenticated users which are connected to conduct an interaction comprising a plurality of messages, repeating act (f) to produce a plurality of groups of connected users or directly compiling an audit trail of the interaction and making information from the audit trail available to the at least two users of each group of connected users during the interaction in an intelligible form wherein the audit trail contains at least some of the content of the plurality of messages in the interaction. One of ordinary skill in the art would have been motivated to do this because it monitors users transactions, which is necessary to reduce future disputes.

Allowable Subject Matter

10. Claims 6-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (**Specifically, the claim 6's limitation**).
11. Claims 12 and 13 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
12. Claims 14-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (**Specifically, the limitations of claim 14**).
13. Claims 22-31 and 33-36 are allowed

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for Regular and After Final Actions and 703-746-9443 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.

September 30, 2004

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY 300